

Application No. 10/085,454
Substitute Amendment dated March 21, 2005
Response to Decision on Petition Under 37 CFR 1.78(a)(3)

REMARKS/ARGUMENTS

Response to Decision On Petition Under 37 CFR 1.78(a)(3)

This Substitute Amendment is filed in response to the Decision on Petition Under 37 CFR § 1.78(a)(3) mailed March 16, 2005. In the Decision, the petition was dismissed for failure to comply with the requirement of 37 CFR 1.78(a)(2)(i) that a nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed applications, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

The prior Amendment filed May 4, 2004, failed to state the relationship of Application No. 29/133,861, filed December 8, 2000, to the instant application. The amendment to the specification now states that "This application is a continuation-in-part of U.S. Provisional Application Serial No. 60/306,743, filed July 20, 2001, now abandoned, which is incorporated herein by reference. This application is a continuation-in-part of Application Serial No. 29/133,861, filed December 8, 2000, now issued U.S. Patent No. D457,556." The only revisions to the amendment filed May 4, 2004, are these references to the prior applications.

Response Filed May 4, 2004

This Amendment is filed in response to the first Office Action dated February 24, 2004. In the Action, claims 1-31, 37 and 38 were indicated to be allowed. Claims 39, 44, and 46-49 are withdrawn. Claims 32 and 33 were rejected under 35 U.S.C. § 102 (b) as anticipated by U.S. Published Application No. 2002/0027837 to Weber ("Weber"). Claims 32, 33, 40-43 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,471,127 to Pentz ("Pentz"). Claims 34, 36, and 45 were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

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On November 11, 2002, the applicants filed an Amendment and Petition seeking to add an inventor not originally named in the application. The Amendment and Petition also seek to claim the benefit of U.S. Application Serial No. 29/133,861, filed December 8, 2000 (now U.S. Patent D457,556). Applicants have not received any indication that the Petition and related Amendment have been acted upon.

The applicants submit that the Petition and Amendment are well grounded and that the present application should be granted the benefit of U.S. Application Serial No. 29/133,861. In anticipation of the grant of the Petition and Amendment, applicants have set forth an amendment to the specification to set forth the priority claim in the present submission, which is conditional upon grant of the Petition and entry of the related Amendment. A copy of issued U.S. Patent D457,556 is included herewith for the Examiner's information.

The applicants note with appreciation the allowance of claims 1-31, 37 and 38. Claim 34 was amended to include all of the limitations of claims 32 and 33. Claim 36 is dependent upon claim 34. Claim 45 has been amended, but does *not* include the limitations of the intervening claims, as described below. New claims 50-52 have been added, and are described in more detail below.

35 U.S.C. § 102(b) Rejection

Claims 32 and 33 have been rejected based on Weber. Claim 32 has been amended to recite that the card includes an aperture for placement of a key-chain loop therethrough. Additionally, the aperture is spaced from the centerline of the card. The amendment finds support in the application as filed, at page 9, lines 14-26, and Figures 1, 5 and 6. The amendment also finds support in Application Serial No. 29/133,861 from which priority is claimed in the pending Petition. Applicants submit that claims 32 and 33 are entitled to the benefit of Application Serial No. 29/133,861.

The cited Weber application does not teach or suggest the use of a key-chain aperture with a magnetic stripe card. Weber includes a central hole for receiving the

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spindle on a standard CD-ROM device (see Weber, paragraph 0020). Weber does not include an aperture for a key chain loop. As set forth in the amended claims, the key chain loop aperture is spaced from the centerline, i.e., it is not a central hole such as in Weber. The hole in Weber must be centrally located in order to allow the CD-ROM device to function. It cannot be located away from the center of the circular disk, or it will interfere with the data stored on the CD-ROM disk. For these reasons, applicants submit that the amendments to claims 32 and 33 distinguish over Weber.

Applicants have submitted herewith an Information Disclosure Statement and cited prior art. As part of that submission, applicants have included Canadian published Application No. 2,300,241 to Weatherford, which discloses a non-conventional sized (or small sized) magnetic stripe card with a key chain loop aperture. However, Weatherford does not disclose a card with an arcuate shaped end, as set forth in amended claims 32 and 33. It is therefore submitted that claims 32 and 33 are also allowable over the Weatherford publication, which is submitted herewith.

Claims 32, 33 and 40-43 have been rejected under 35 U.S.C. § 102 (b) as anticipated by Pentz et al., U.S. Patent No. 6,471,127. The Pentz '127 patent issued on October 29, 2002. The Pentz application was published as publication no. 2002/0092914, on July 18, 2002. Applicants submit that neither of these dates qualifies Pentz et al. as a reference under 35 U.S.C. § 102(b) in that the present application is entitled to a filing date of February 27, 2002. Moreover, the present application claims priority on a provisional application filed July 20, 2001 (notwithstanding the pending Petition to claim an earlier priority date). Either of these dates is sufficient to antedate Pentz et al. as a prior art reference under § 102(b).

As noted above, applicants have filed a Petition and Amendment seeking to claim priority on Application Serial No. 29/133,861, filed December 8, 2000. Applicants submit that claims 32, 33, and 40-43 are entitled to a priority date of December 8, 2000, based on the disclosure of Application Serial No. 29/133,861.

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The Office Action did *not* apply Pentz to the pending claims under 35 U.S.C. § 102(e). The Pentz '127 patent is based on an application filed November 19, 2001 (Serial No. 09/988,151). Applicants' present application, which was filed on February 27, 2002 (Serial No. 10/085,454), claims priority on a provisional application filed July 20, 2001 (Serial No. 60/506,743). Accordingly, Pentz's November 19, 2001 filing date is not sufficient to predate the priority date of the present application, and the Pentz '127 patent, on its face, does not qualify as prior art under 35 U.S.C. § 102(c).

However, the Pentz '127 patent claims priority on: (1) a non-provisional application filed July 6, 2000 (Serial No. 09/611,320); (2) a provisional application filed January 25, 2001 (Serial No. 60/263,756); and, (3) 15 separate design patent applications filed on May 11, 2001 or May 22, 2001. Assuming that the applicants of the present application are granted their pending Petition and Amendment and permitted to claim priority back to December 8, 2000 for pending claims 32, 33 and 40-43, only the Pentz application filed on July 6, 2000 (Serial No. 09/611,320), to the extent that application is reflected in the disclosure of the Pentz '127 patent, is potentially prior art to pending claims 32, 33, and 40-43 under 35 U.S.C. § 102(e).

With an Information Disclosure Statement filed herewith, applicants have submitted copies of the prosecution history files of (1) Pentz Application Serial No. 09/611,320, filed July 6, 2000, and (2) Pentz Application Serial No. 60/263,756, filed January 25, 2001, which were obtained from the Patent and Trademark Office files. The July 6, 2000 application of Pentz (Serial No. 09/611, 320) does not disclose Figures 13A and 13B, which were referenced in the Office Action as showing the curved left and right side edges. The January 21, 2001 application of Pentz (Serial No. 60/263,756) also does not include Figures 13A and 13B, which are the Figures in Pentz referenced in the Office Action.

Applicants have filed a Petition and Amendment to claim priority on the application filed December 8, 2000 (Serial No. 29/133,861). That petition, if granted, will

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allow applicants to antedate the earliest relevant application for the Pentz '127 patent, and remove Pentz '127 as a potential prior art reference under 35 U.S.C. § 102(e).

Claims 32, 33, 40-43 are therefore entitled to a priority date prior to the earliest relevant priority date for the Pentz et al. '127 patent, assuming the grant of applicants' petition. Claims 32, 33, 40-43 are therefore allowable over the Pentz et al. '127 patent.

New claims 50-52 describe the card and associated case of the present invention, along with the key hole aperture. The recitation of the card in claims 50-52 is not limited to an asymmetrical shape or card having one arcuate portion. Applicants submit that new claims 50-52 are properly presented in this application and define allowable subject matter over the art of record.

In summary, claims 1-31, 37 and 38 have been allowed; claims 32, 34, 43 and 45 have been amended; claims 39, 44 and 46-49 are withdrawn; and, new claims 50-52 have been added. Accordingly, claims 1-38, 40-43, 45 and 50-52 are submitted to be allowable, and allowance is respectfully requested.

Should the Examiner wish to discuss the above application, it is requested that the favor of a telephonic interview be granted to their attorney indicated below.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

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Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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